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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/576,384	06/09/2006	Clive Erskine	06142.0005U1	1866
23859 7590 08/13/2007 NEEDLE & ROSENBERG, P.C. SUITE 1000 999 PEACHTREE STREET ATLANTA, GA 30309-3915			EXAMINER MI, QIUWEN	
			ART UNIT 1655	PAPER NUMBER
			MAIL DATE 08/13/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/576,384	<b>Applicant(s)</b> ERSKINE, CLIVE	
	<b>Examiner</b> Qiuwen Mi	<b>Art Unit</b> 1655	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 02 July 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) 1-14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 15-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 4/19/2006
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### Election/Restrictions

Applicant's election with traverse of Group III, claim 15, and species methyl, polar oil, and *Tasmannia stipitata*, in the reply filed on 7/2/07, is acknowledged. The traversal is on the ground(s) that reference US 5,776,481 does not teach the special technical feature.

The inventions listed as Groups I-III do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: As Grinda et al. disclose a method of extracting a natural insecticidal substance from a plant containing the insecticidal substance which comprises contacting powdered dry parts of the plant with an alkyl or alkenyl ester of a fatty acid, in which the ester moiety contains 1-16 carbons (see claim 1). Grinda et al. also teach that the ester is methyl, ethyl, propyl, isopropyl, butyl, hexyl, and octyl etc (see claim 3). Grinda et al. further teach that the product serves as spray for plants in order to protect them against insect (col 3, lines 5-10). Therefore, there is no special technical feature in the application. Accordingly the groups are not so linked as to form a single general concept under PCT Rule 13.1., and therefore lack of unity of invention exists.

The requirement is still deemed proper and is therefore made FINAL.

Claims 1-14 are withdrawn from further consideration as being drawn to nonelected inventions.

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### **Claims Pending**

Claims 16-21 are newly submitted, which are drawn to the elected Group III. Claims 1-21 are pending. Claims 1-14 are withdrawn. Claims 15-21 are examined on the merits.

### **Claim Rejections –35 USC § 102**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 15, 17, and 18 are rejected under 35 USC § 102 (b) as being anticipated by Grinda et al (US 4,698,222).

Grinda et al. disclose a method of extracting a natural insecticidal substance from a plant containing the insecticidal substance which comprises contacting powdered dry parts of the plant with an alkyl or alkenyl ester of a fatty acid, in which the ester moiety contains 1-16 carbons (see claim 1). Grinda et al. also teach that the ester is methyl, ethyl, propyl, isopropyl, butyl, hexyl, and octyl etc (see claim 3). Grinda et al. further teach that the product serves as spray for plants in order to protect them against insect (col 3, lines 5-10). It is inherent that the fatty acid ester is produced by esterification of an animal or vegetable oil.

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Applicant is requested to note that it is regarded that "intended use" or preamble of a composition or product will not further limit claims drawn to a composition or product. See, e.g., Ex Parte Masham, 2 USPQ2d 1647 (1987) and In Re Hack 114, USPQ 161. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Therefore, the reference is deemed to anticipate the instant claim above.

### **Claim Rejections –35 USC § 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 15-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grinda et al (US 4,698,222) in view of WO 01/15534.

Grinda et al. disclose a method of extracting a natural insecticidal substance from a plant containing the insecticidal substance which comprises contacting powdered dry parts of the plant with an alkyl or alkenyl ester of a fatty acid, in which the ester moiety contains 1-16 carbons (see claim 1). Grinda et al. also teach that the ester is methyl, ethyl, propyl, isopropyl, butyl, hexyl, and octyl etc (see claim 3). Grinda et al. further teach that the product serves as spray for plants

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in order to protect them against insect (col 3, lines 5-10). It is inherent that the fatty acid ester is produced by esterification of an animal or vegetable oil.

Grinda et al. do not teach a composition further comprising a pesticidally active polar oil, a solvent, or the plant material *Tasmannia stipitata*.

WO 01/15534 discloses an insecticidal composition that includes *Tasmannia stipitata* extract in combination with an insecticidally effective oil such as vegetable oil (polar oil) etc. The *Tasmannia stipitata* extract enhances the insecticidal activity of the oil (see Abstract). WO 01/15534 also teaches that the composition is applied to the insect population by spraying (claim 8), and the extract was dissolved in ethanol (solvent) (page 3, lines 10-15). WO 01/15534 further teaches that the combination of *Tasmannia stipitata* extract and insecticidally effective vegetable oil have been found to have unexpected synergistic activity as insecticides (page 1, lines 25-30).

Therefore, it would have been *prima facie* obvious for one of ordinary skill in the art at the time the invention was made to use the pesticidally active vegetable oil (polar oil), solvent ethanol, and plant material *Tasmannia stipitata* from WO 01/15534 in the invention of Grinda et al since WO 01/15534 teaches that the combination of *Tasmannia stipitata* extract and insecticidally effective vegetable oil have been found to have unexpected synergistic activity as insecticides. Since both of the inventions teach pesticides from plant material individually in the art, and since both of the compositions yielded beneficial results in pest control, one of ordinary skill in the art would have been motivated to make the modifications.

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From the teachings of the references, it is apparent that one of the ordinary skills in the art would have had a reasonable expectation of success in producing the claimed invention.

Applicant is requested to note that it is regarded that "intended use" or preamble of a composition or product will not further limit claims drawn to a composition or product. See, e.g., *Ex Parte Masham*, 2 USPQ2d 1647 (1987) and *In Re Hack* 114, USPQ 161. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Thus, the invention as a whole is *prima facie* obvious over the references, especially in the absence of evidence to the contrary.

### Conclusion

No claim is allowed.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Qiuwen Mi whose telephone number is 571-272-5984. The examiner can normally be reached on 8 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terry McKelvey can be reached on 571-272-0775. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Qiuwen Mi

/Patricia Leith/  
Patricia Leith  
Primary Examiner  
Art Unit 1655